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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,058	08/27/2002	Thierry Barge	4747-4600	9030
28765	7590	01/31/2005	EXAMINER	
WINSTON & STRAWN PATENT DEPARTMENT 1400 L STREET, N.W. WASHINGTON, DC 20005-3502			PIZARRO CRESPO, MARCOS D	
			ART UNIT	PAPER NUMBER
			2814	

DATE MAILED: 01/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/069,058

Applicant(s)

BARGE ET AL.

Examiner

Marcos D. Pizarro-Crespo

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2004 and 06 December 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 28-40 is/are allowed.
- 6) ☒ Claim(s) 41-47 and 49-52 is/are rejected.
- 7) ☒ Claim(s) 48 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Attorney's Docket Number: 4747-4600

Filing Date: 8/27/2002

Claimed Foreign Priority Date: 8/17/2000 (371 PCT/FR00/02330)
8/20/1999 (FR 99/10667)

Applicant(s): Thierry Barge, et al.

Examiner: Marcos D. Pizarro-Crespo

DETAILED ACTION

This Office action responds to the amendments filed on 10/7/2004 and 12/6/2004.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after the final rejection mailed on 8/27/2004. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/6/2004 has been entered.

Acknowledgment

2. The amendments filed on 10/7/2004 and 12/6/2004, responding to the Office action mailed on 8/27/2004 have been entered. The present Office action is made with all the suggested amendments being fully considered. Accordingly, pending in this Office action are claims 28-52.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 45 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 45 recites the limitation "the oxide" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 41, 42, 46, 47, and 49-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Malik (US 2002/0173872), Maszara and Van Zant.

9. Regarding claim 41, Malik shows (see, e.g., fig. 1A and par. 0053) most aspects of the instant invention including a process for treating microelectronic or optoelectronic substrates **12** that have a working layer **10** with a free surface thereof, which process comprises annealing the substrate **12** under a reductive atmosphere to assist in smoothing the free surface, and then chemical mechanical polishing of the free surface to prepare it for further processing (see, e.g., par. 0054).

Malik, however, fails to specify how much substrate is removed during the polishing step. However, the claimed removed thickness will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such thickness is critical. "Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the workable ranges by routine experimentation". *In re Aller*, 220 F.2d 454,456,105 USPQ 233, 235 (CCPA 1955).

Maszara (see, e.g., pp.130/II.38-39), for example, teaches that the thickness of the portion of the working layer that is removed by polishing is subject to optimization. Exemplary measurements of the loss of film thickness are about 600-700 angstroms. Van Zant (see, e.g., pp.63/II.20-26), on the other hand, teaches that the thickness of the removed portion of the working layer is determined based on the initial free-surface topography such that a substantially planar surface is formed.

Since the applicant has not established the criticality (see next paragraph) of the thickness of the working layer that is removed by polishing, and since similar thicknesses have been removed in similar processes in the art, it would have been obvious to one of ordinary skill in the art to use these values in the process of Malik.

CRITICALITY

10. The specification contains no disclosure of either the critical nature of the claimed removed thickness or any unexpected results arising therefrom. Where patentability is said to be based upon particular chosen dimensions or upon another variable recited in a claim, the applicant must show that the chosen dimensions are critical. *In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

11. Regarding claim 42, Malik (see, e.g., par. 0053) teaches that the reductive atmosphere comprises hydrogen.

12. Regarding claim 46, Malik (see, e.g., par. 0053) teaches the process further comprising conducting one or more heat treatments of the substrates as the further processing.

13. Regarding claim 47, Malik (see, e.g., par. 0053) teaches the process further including a step of oxidizing the working layer after polishing.

14. Regarding claim 49, Malik (see, e.g., par. 0053) teaches the process further comprising annealing the substrate after the polishing step in order to improve the qualities of the working layer.

15. Regarding claim 50, Malik (see, e.g., par. 0028) teaches that the process further comprises a step wherein the working layer is provided by implanting atoms into a wafer to form a weakened atom implantation zone that defines the working layer, bonding the wafer to the substrate and then detaching the working layer from the wafer along the weakened zone.

16. Regarding claims 51 and 52, Malik's working layer is made of silicon (see, e.g., par. 0030).

17. Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over Malik/Maszara/Van Zant in view of Kobayashi (US 6531416).

18. Regarding claim 43, Malik/Maszara/Van Zant shows most aspects of the instant invention (see paragraph 9 above), except for the annealing temperature. Kobayashi, on the other hand, teaches that a temperature between 1200-1230°C will significantly decrease the COP density of Malik's working layer.

It would have been obvious at the time of the invention to one of ordinary skill in the art to use an annealing temperature between 1200-1230°C in the method of Malik/Maszara/Van Zant, as suggested by Kobayashi, to decrease the COP density of the working layer.

19. Claims 44 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Malik/Maszara/Van Zant in view of Maleville (US 6403450).

20. Regarding claim 44, Malik/Maszara/Van Zant shows most aspects of the instant invention (see, e.g., par. 0053), except for the process further comprising a step of oxidizing the working layer prior to polishing to provide at least a portion of the free surface as an oxide. Maleville, on the other hand, teaches that doing so increases the effectiveness of the polishing step by largely reducing the roughness of the working layer before polishing.

It would have been obvious at the time of the invention to one of ordinary skill in the art to include in the process of Malik/Maszara/Van Zant a step of oxidizing the working layer prior to polishing, as suggested by Maleville, to increase the effectiveness of the polishing step.

21. Regarding claim 45, Maleville (see, e.g., col.7/ll.3-7) teaches that the method may further comprise a step of removing a portion of an oxide prior to annealing.

Allowable Subject Matter

22. Claims 28-40 are allowed.
23. Claim 48 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

24. Applicant's arguments with respect to claims 41-52 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

25. Papers related to this application may be submitted directly to Art Unit 2814 by facsimile transmission. Papers should be faxed to Art Unit 2814 via the Art Unit 2814 Fax Center. The faxing of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (15 November 1989). The Art Unit 2814 Fax Center number is **(703) 872-9306**. The Art Unit 2814 Fax Center is to be used only for papers related to Art Unit 2814 applications.
26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Marcos D. Pizarro-Crespo** at **(571) 272-1716** and between the hours of 9:30 AM to 8:00 PM (Eastern Standard Time) Monday through Thursday or by e-mail via Marcos.Pizarro@uspto.gov. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wael Fahmy, can be reached on (571) 272-1705.

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27. Any inquiry of a general nature or relating to the status of this application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

28. The following list is the Examiner's field of search for the present Office Action:

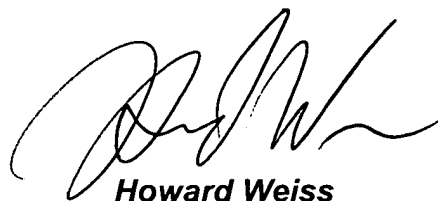
Field of Search	Date
U.S. Class / Subclass(es): 438/4,406,455-459,471-477,692,795-799,974,977; 117/2; 156/610	1/22/2005
Other Documentation:	
Electronic Database(s): EAST (USPAT, EPO, JPO, PGPub)	1/22/2005

Marcos D. Pizarro-Crespo

Patent Examiner

Art Unit 2814

571-272-1716

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Primary Examiner

Art Unit 2814